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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of : Confirmation No. 1298
Nariie KANEKO : Docket No. 2001_0571A
Serial No.09/849,968 : Group Art Unit 3728
Filed May 8, 2001 : Examiner M. Patterson

GOLF SHOES

APPELLANTS' BRIEF

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This is an appeal from the final rejection of claims 4-17.

1. REAL PARTY IN INTEREST

The real party in interest is the assignee of record, Two and One Co., Ltd. of Osaka, Japan.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

3. STATUS OF CLAIMS

The claims on appeal are claims 4-17. The application was originally filed with claims 1-3; however, in the amendment filed June 20, 2002, claims 1-3 were cancelled and replaced by new claims 4-17.

4. STATUS OF AMENDMENTS

The only amendment to claims 4-17 subsequent to issuance of the final Office Action, is an amendment filed concurrently with this appeal brief.

The amendment, if entered, will amend dependent claim 8 to depend from claim 6 instead of claim 5. The purpose of this amendment is to provide proper antecedent basis in the claims for the term "said release valve" recited in claim 8.

It is noted that the claims in the attached Appendix do not include this amendment.

5. SUMMARY OF THE INVENTION

With exemplary reference to the drawing figures, independent claim 4 is directed to a pair of golf shoes comprising a shoe 10 having a sole (e.g. 13L) including a rearward portion and a forward portion, the forward portion having an inside portion at one lateral side adapted to receive a big toe portion of a foot and an outside portion at the other lateral side adapted to receive a little toe portion (e.g. 15L) of the foot. As shown in Figs. 1A and 1B, an inflatable sealed bag 2 is provided only at the outside portion of the forward portion of the sole; the inside portion of the sole has no inflatable sealed bag. The inflatable sealed bag 2 has an air port (bottom end of the tube 3) through which air can be injected to inflate the sealed bag 2. The sealed bag 2 is arranged at the outside portion of the forward portion of the sole 13L so that, when the foot is received in the shoe 10 and the sealed bag 2 is inflated, the little toe portion 15L of the foot is raised relative to the big toe portion of the foot, as illustrated in Figs. 4C and 5C.

The dependent claims 5-10 are directed to additional preferred features of the invention. In this regard, a hand pump 4 is communicated with the air port of the sealed bag 2 for use in inflating the sealed bag 2. A release valve 5 is coupled to the sealed bag 2 for releasing air from the sealed bag 2. Preferably, the shoe includes a tongue 6, and the hand pump 4 is buried in the tongue 6, as also illustrated in Figs. 1A and 1B. It is also preferred that the release valve 5 be buried in the tongue 6.

With this arrangement of the present invention, the sealed bag 2 can be inflated prior to the golfer taking a swing, so that the little toe portion 15L of one of the golfer's feet (in particular, of the left foot for a right-hand golfer, or the right foot for a left-handed golfer) is raised relative to the big toe portion of the foot. This little toe portion 15L (for a right-hand golfer) serves as a bracing portion during a downswing and, with the sealed bag inflated, allows for proper bracing even for a golfer, for example a senior golfer, who has a somewhat weakened lower body. This bracing function allows for the golf swing to be correctly performed. After the swing, the inflatable sealed bag 2 can be deflated so that the golfer can walk normally (see paragraphs [0010] and [0011] on page 3 of the specification).

Independent claim 11 includes all of the requirements of independent claim 4, but further specifies that the pair of golf shoes includes a second shoe which, as illustrated in Figs. 4C and 5C, has no inflatable sealed bag.

6. ISSUES

The issues presented for review are:

(a) whether claims 4-17 are unpatentable under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and

(b) whether claims 4-17 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. 4,446,634) in view of Wellman (U.S. 4,875,683) and, in the case of claims 5-9 and 13-17, further in view of Cohen (U.S. 5,133,599).

7. GROUPING OF CLAIMS

(a) For the issue of patentability under 35 U.S.C. 112, second paragraph, the claims 4-17 stand or fall together, with claim 4 being the broadest claim.

(b) For the issue of patentability under 35 U.S.C. 103(a), the claims stand or fall together, again with claim 4 being the broadest claim.

8. ARGUMENT

Issue (a): whether claims 4-17 are unpatentable under 35 U.S.C. 112, second paragraph, as being indefinite.

In the rejection under 35 U.S.C. 112, second paragraph, as presented in the final Office Action, the Examiner stated that, in claims 4 and 11, the open-ended language of "golf shoes comprising" contradicts the limiting language of "bag provided only at said outside portion" and "... having no inflatable sealed bag."

However, it is submitted that the open-ended term "comprising" as used in the present claim is not contradictory to the negative limitations using the terms "only" and "having no . . ." Specifically, the claim preambles which recite the term "comprising" are, in fact, open-ended preambles, as the Examiner stated. Accordingly, the claims are to be construed to cover golf shoes that include all of the features specifically recited in the claims, as well as perhaps additional features. The recitation in claim 4 that the "inflatable sealed bag [is] provided only at said outside portion of said forward portion of said sole" is very explicit and clearly understandable; it prevents claim 4 from covering a pair of golf shoes that includes a shoe having a sealed bag (or bags) at a location (or locations) other than "at said outside portion of said forward portion of said sole," but it does not otherwise prevent claim 4 from covering golf shoes that include features other than those specifically recited in the claim. For example, a pair of golf shoes would clearly be encompassed by claim 4 if the pair of shoes includes a shoe conforming to all of the features recited in claim 4, but also includes, for example, shoe laces (or a steel toe reinforcing member or a decorative emblem or, for that matter, any other element not explicitly excluded by claim 4). In other words, the negative limitation "only at said outside portion of said forward portion of said sole" relates only to "an inflatable sealed bag;" it does not in any way prevent the claim from encompassing golf shoes that also include additional elements not explicitly set forth in the claims other than as explicitly excluded.

Similarly, claim 4 specifies that the "inside portion of said forward portion of said sole [has] no inflatable sealed bag thereat." This limitation does in fact preclude the claim from

covering a pair of golf shoes that includes a shoe having an inflatable sealed bag at the inside portion of the forward portion of the sole, since such is explicitly excluded. There is nothing ambiguous or indefinite about this claim language; the scope of the claim is readily ascertainable from its explicit language.

"In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph. See, e.g. *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000)." MPEP §2173.02.

Also, attention is directed to MPEP §2173.05(i) which states the current view of the courts as being that there is nothing inherently ambiguous or uncertain about a negative limitation, so long as the boundaries of the patent protection sought are set forth definitely. This same section of the MPEP cites an exemplary case, *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970), in which a claim including a negative limitation was considered definite because each recited limitation was definite.

The same reasoning applies to the language of claim 11 which includes the open-ended preamble term "comprising", and, in the body of the claim, recites

"an inflatable sealed bag provided only at said outside portion of said forward portion of said sole of only one of said right foot shoe and said left foot shoe, said inside portion of said forward portion of said sole of said one of said right foot shoe and said left foot shoe having no inflatable sealed bag thereat, and the other of said right foot shoe and said left foot shoe having no inflatable sealed bag."

This quoted language from the body of claim 11 clearly encompasses only a pair of golf shoes wherein one of the shoes has an inflatable sealed bag at the outside portion of the forward portion of the sole, and wherein the other shoe has no inflatable sealed bag at all. Thus, the scope of claim 11 is clearly ascertainable, and the inclusion of the negative limitations does not conflict with the open-ended term "comprising" in the preamble, for the reasons discussed above. That is,

the open-ended term "comprising" in the preamble leaves the claim open to covering a pair of golf shoes that includes elements not specifically recited in the claim, with the exception of the explicit exclusions included in the third paragraph of the body of claim 11 as quoted above.

Thus, it is submitted that the independent claims 4 and 11 clearly define the metes and bounds of the claim scopes, notwithstanding the use of the preamble term "comprising" and the negative limitations included in the bodies of the claims. Therefore, it is submitted that the claims clearly comport with the requirements of 35 U.S.C. 112, second paragraph, and that the rejection should be reversed.

* * * * *

Issue (b): whether claims 4-17 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. 4,446,634) in view of Wellman (U.S. 4,875,683) and, in the case of claims 5-9 and 13-17, further in view of Cohen (U.S. 5,133,599).

On pages 2 and 3 of the final Office Action, the Examiner rejected claims 4 and 10-12 under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. 4,446,634) in view of Wellman (U.S. 4,875,683); and rejected claims 5-9 and 13-17 under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wellman and Cohen (U.S. 5,133,599). It is respectfully requested that these rejections be reversed, for the following reasons.

The Johnson patent explicitly discloses an inflatable bag at each of the four quadrants of the sole of each of a pair of shoes (see Fig. 6). The Examiner thus cited the Wellman patent for teaching "providing a shoe sole with mean[s] for elevating only the forefoot lateral (outside) portion of one shoe in a pair of shoes (see column 4, lines 43-46 and column 5, lines 7-22)." From this teaching of Wellman, the Examiner concluded that

"it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the bags except for at the forefoot lateral position (outside) of one shoe to obtain a slant as desired by Wellman in the shoes of Johnson, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art." *In re Karlson*, 136 USPQ 184."

However, the *In re Karlson* case stands for the proposition that the omission of an element and its function in a combination is an obvious expedient only if the remaining elements perform the same functions as before (i.e. before the omission). This clearly is not the situation at hand.

That is, to eliminate the rear inflatable bags 18A and 18B, as well as the inside front inflatable bag 20B of one of the shoes of the Johnson patent (in order to meet present claim 4) and to further eliminate all four of the inflatable bags 18A, 18B, 20A and 20B of the other shoe of the Johnson patent (in order to meet present claim 11), would not result in the Johnson patent's "remaining elements [performing] the same functions as before." Rather, the explicit purpose of the invention disclosed in the Johnson patent is to provide "a means of significantly reducing the shock by absorbing it in the same nature as a shock absorber used on automobiles; that is, in which the shock is absorbed by the movement of fluid" (column 1, lines 22-25 of the Johnson patent). This is accomplished not simply by having bladders independently placed in locations in the sole of the shoe, but rather by providing the bladders 18A, 18B, 20A and 20B with conduits extending therebetween "so that when the heel strikes the ground the weight of the heel portion of the foot of the user forces fluid to flow from the first bladder, through the conduit, to the second bladder under the ball portion. As the foot rolls forward and weight is transferred from the heel to the ball portion, the fluid in the bladder under the ball portion of the foot receives and supports the weight of the user and absorbs shock by transferring fluid from that portion back into the bladder under the heel portion." (See column 1, lines 30-40 of the Johnson patent).

Accordingly, if three of the four inflatable bags (i.e. the rear bags 18A and 18B and the inside, front bag 20B) illustrated in Fig. 6 of Johnson were omitted from one of the Johnson shoes, essential functions of the Johnson arrangement required to attain the object of the Johnson invention, would be eliminated. That is, the modified Johnson shoe would have only a single inflatable bag 20A and thus fluid could not be forced either into the bag 20A from another bag when the heel strikes the ground or out of the bag 20A as the foot rolls forward and weight is transferred to the front (ball) portion of the foot. As such, the modified Johnson shoe would no

longer reduce shock by absorbing it "by the movement of fluid" in the manner of an automobile shock absorber, as is specifically described in Johnson (column 1, lines 22-25) as an intended purpose of the Johnson shoes.

Therefore, the Johnson shoes modified as suggested by the Examiner by eliminating the bags 18A, 18B and 20B would no longer perform the same function of providing shock absorption by movement of fluid between the bags as weight is transferred from one part of the foot to another.

Further, the fact that the modification of the Johnson patent suggested by the Examiner would render the Johnson arrangement inoperable for its intended purpose, means that the Johnson patent in fact teaches away from any such modification. "There is no suggestion to combine ... if a reference teaches away from its combination with another source." *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir. 2000). Also see *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Regarding the Examiner's comment at the top of page 4 of the final Office Action that "Johnson clearly suggests using the laterally divided bags to control slant of the foot by providing a wedge effect in the shoe (column 4, lines 1-26)," it is noted that this deals only with an increase or decrease in the amount of fluid in the individual bladders, and does not in any way contemplate the omission of any of the bladders. In fact, omission of the bladders would also frustrate the shock absorbing purpose of the Johnson invention.

Next, in the second paragraph on page 4 of the Office Action, the Examiner stated that "in response to Applicants' arguments that Johnson has additional components, it is noted that Applicant has used open language in the claims, i.e. 'comprising' and the fact that Johnson may show additional components does not negate the fact that Johnson does show the elements that are claimed." First, this statement by the Examiner would seem quite contrary to the fact that the Examiner has applied a combination of Johnson in view of Wellman, and taken the position that

the teachings of the Wellman patent would have rendered it obvious to omit three of the four bags of the Johnson patent.

Second, as discussed above in connection with the rejection under 35 U.S.C. 112, second paragraph, the explicit limitations of claims 4 and 11 make clear the requirements of these claims. The "comprising" language of the preamble does in fact allow the claims to encompass golf shoes having elements not explicitly recited in the claims. However, the claim language makes it equally clear that the claims do not encompass golf shoes having inflatable sealed bags at all four quadrants of the shoes as disclosed in the Johnson patent. Thus, to uphold the Examiner's position, the explicit (albeit negative) limitations of claims 4 and 11 must be ignored. As explicitly stated in MPEP §2143.03, "to establish *prima facia* obviousness of a claimed invention, all of the claim limitation must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." Therefore, it is submitted that the Examiner's statement in the second paragraph on page 4 of the final Office Action cannot provide a basis for holding the present claims unpatentable.

The Examiner cited the Cohen patent for teaching "providing a hand pump (28) on a tongue of the shoe for inflating and deflating air bags." However, the Cohen patent provides no teaching or suggestion that would obviate the above-discussed shortcomings of the Johnson and Wellman patents.

For the above reasons, it is respectfully submitted that the independent claims 4 and 11, as well as the dependent claims 5-10 and 12-17 which respectively depend therefrom, are clearly patentable over the prior art as applied by the Examiner. Therefore, it is respectfully requested that the prior art rejections be reversed.

9. APPENDIX

A copy of the claims on appeal is set forth in an Appendix immediately following the conclusion and signature, and is incorporated herein by reference.

CONCLUSION

This brief is submitted in triplicate with the requisite fee of \$160.00.

Respectfully submitted,

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February 3, 2003